FILE COPY

FILED
SEP 17 1946
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM, 1946

No. 441

GEORGE W. BENZ, JOSE B. CALVA AND CALVA FUR PATENTS CORPORATION,

Petitioners,

vs.

CELESTE FUR DYEING & DRESSING CORP., ROSELAND MOUTON CORP., ANNA HOLDING CORP., CELESTE BOGLIOLI, DAVID BOGLIOLI AND CHARLES KALB,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITIONERS' PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

DANIEL L. MORRIS,
Counsel for Respondents.

INDEX

PAGE

Statement 1

History of the Litigation 2

Basis of the Litigation and Judgment 2

Cases Cited

Muncie Gear Works, Inc. *v.* Outboard M. & M. Co., 315 U. S. 759, 62 S. Ct. 865 4

U. S. Industrial Chemicals, Inc. *vs.* Carbide & Carbon Chemicals Corporation, 315 U. S. 668, 62 S. Ct. 839 ... 3, 4

Supreme Court of the United States

OCTOBER TERM, 1946

No. 441

GEORGE W. BENZ, JOSE B. CALVA AND CALVA FUR PATENTS CORPORATION,

Petitioners,

vs.

CELESTE FUR DYEING & DRESSING CORP., ROSELAND MOUTON CORP., ANNA HOLDING CORP., CELESTE BOGLIOLI, DAVID BOGLIOLI AND CHARLES KALB,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITIONERS' PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Statement

This petition for writ of certiorari is based upon Petitioners' misapprehension that the District Court determined issues of fact, set aside the verdict and entered judgment on respondents' motions under rule 50 F. R. C. P. upon such determination, and that the Circuit Court of Appeals affirmed the District Court on the same basis; whereas, in fact, the District Court, in setting aside the

verdict and entering judgment for respondents, "dealt solely with questions of law" (R. p. 916), and the Circuit Court of Appeals affirmed on the same basis.

This being true, the cases cited by petitioners are not pertinent because they all deal with the entry of judgment *non obstante verdicto* after the trial court reversed the jury on the facts.

History of the Litigation

This case was originally tried before a judge and jury, a verdict rendered for petitioners, an appeal was taken and the judgment reversed, and the case sent back to the District Court for a new trial (136 F. 2nd 845). The new trial was had and a verdict was rendered for petitioners; the verdict was set aside and judgment entered for respondents under Rule 50 F. R. C. P. (R. pp. 504-5) and an appeal was taken, and the Circuit Court of Appeals affirmed the District Court (R. p. 915).

Basis of the Litigation and Judgment

This suit is for damages for infringement of United States Letters Patent No. 2,240,388 to Calva, filed February 24, 1941 and issued April 29, 1941.

The patent was called a "division" of an earlier "parent" application filed in 1936.

At the trial petitioners, themselves, proved "a remarkably successful commercial use of the process which defendants (respondents) are said to infringe" (136 F. 2nd 845, at 847), as of a date (October, 1937), subsequent to the 1936 filing date of the "parent" application, but more than two years prior to the filing date of the 1941 application of the so-called "divisional" patent on which the suit is based.

The 1936 application disclosed a process for treating sheep's wool, which process involved the use of acid, formaldehyde and cresol, and cresol was said to be the "most important" of the ingredients. The District Court and the

Court of Appeals interpreted this disclosure as meaning that cresol was made mandatory by the applicant. Respondents use formaldehyde and acid but they do not use cresol. There is no disagreement as to this fact.

Having so interpreted this document, the lower courts both reached the legal conclusion that the 1941 application can not receive the benefit of the 1936 filing date unless the 1941 application also makes the use of cresol mandatory. If it does make cresol mandatory, respondents do not infringe because they do not use cresol. If it makes the use of cresol optional, the 1941 application is not a "division" and hence can not be given the benefit of the 1936 filing date and in this event, the 1937 public use (proved by petitioners) is a statutory bar which renders the patent in suit invalid.

The Circuit Court of Appeals, in interpreting the document as filed, held that the "parent" application made the use of cresol mandatory (as did also the District Court); and in interpreting the document held that the "divisional" patent made the use of cresol optional and was invalid because of the existence of the petitioner-proved public use above referred to (R. pp. 918-9).

To reach their determination, the courts below were dealing solely with questions of law—the interpretation of the "parent" application and of the "divisional" patent.

True, much expert and other testimony was offered by petitioners and received by the trial court, on the basis of the rule laid down by this court in *U. S. Industrial Chemicals, Inc.* vs. *Carbide & Carbon Chemicals Corporation*, 315 U. S. 668, 62 S. Ct. 839, to aid the court in the understanding of the language and terms of the "parent" application and of the "divisional" patent.

Calva admitted that he had not invented a cresol-free process prior to the filing of his "parent" application. This served the purpose of assuring the District Court and the Circuit Court of Appeals that they were correct in their interpretation of the language of the "parent" application that the use of cresol was mandatory.

In arriving at their conclusions both courts below dealt solely with questions of law, *U. S. Industrial Chemicals, Inc.* vs. *Carbide & Carbon Chemicals Corporation*, 315 U. S. 668, 62 S. Ct. 839; *Muncie Gear Works, Inc.* v. *Outboard M. & M. Co.*, 315 U. S. 759, 62 S. Ct. 865. This being true, there is nothing for this court to review because the determination of questions of law is the function of the court. The courts below exercised this function, and committed no error.

Respectfully submitted,

DANIEL L. MORRIS,
Counsel for Respondents.